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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,418	07/27/2006	Jochen Moench	3775	7301
7590 Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743				
EXAMINER				
MACARTHUR, VICTOR L				
ART UNIT		PAPER NUMBER		
3679				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/587,418

**Applicant(s)**

MOENCH ET AL.

**Examiner**

VICTOR MACARTHUR

**Art Unit**

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/2/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/9/2008 has been entered.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "width dimension" (lines 12-13 of claim 1), "rotation direction" (lines 13-14 of claim 1) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities:

- The phraseology "is configured mechanically connect" is improper and should be replaced with --is configured to mechanically connect--.

Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as follows regarding lines 12-16 of claim 1:

- It is unclear how (Y) can be the "circumference direction" when the drawings show (Y) extending into the drawing in figure 2 such that it would appear at least parallel, if not coincident with (25) in figure 1, thereby rendering it an axial direction. How

can an axial direction be a circumference direction? How can a straight line dimension such as (Y) be considered a circumference direction?

- It is unclear how (X) can be an axial dimension as shown in figure 2 since it would not appear to be parallel to the central axis 25 as seen in figure 1.
- It is unclear how “a width dimension” can be “in a predetermined circumference direction”. Does the applicant mean to claim a width measured at a specific point on an outer circumference? Is the width somehow curve with the outer circumference? If so does it extend about the entire outer circumference?
- It is unclear the “relative to the rotation direction of the motor shaft” means to refer to the “circumference direction”, the “width”, both or neither.

For the reasons mentioned above a great deal of confusion and uncertainty exists as to the proper interpretation of the claim limitations. In accordance with the MPEP § 2173.06, rejection under 35 U.S.C. 102 or 35 U.S.C. 103 follows based on the examiner’s best understanding of the claim scope.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Zagorski (U.S. Patent 3,401,282).

Claim 1. Zagorski discloses (Figs.1-6) all of the claimed connecting device structure as follows: a connecting device, comprising: at least one connecting element (14) wherein the at least one connecting element has a width dimension in a predetermined circumference direction, wherein said width dimension in said predetermined circumference direction is smaller than an axial dimension and a radial dimension of said at least one connecting element, and wherein said connecting device is configured mechanically connect. Furthermore:

- Note applicant's statement that "only the connection device is intended to be claimed, NOT a combination of the connecting device with the various elements to be connected" (lines 17-18 of page 9 of the Remarks filed 12/17/2007).
- The claim is drawn to "A connecting device" not a positive combination of --An assembly comprising a motor and transmission connected by a connecting device--. As detailed above, the prior art "connecting device" structure is substantially identical to the claimed structure and thus equally "configured" to perform the claimed intended functional usage with an engine and transmission. These claimed properties or functions are presumed to be inherent, thus presenting a *prima facie* case (*In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 [CCPA 1977]) and properly shifting the burden of submitting evidence proving otherwise to the applicant (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 [Fed.Cir. 1990]) in accordance with MPEP §2112.01 (I). If applicant truly wishes to limit the scope of the claim to positively require an engine and transmission then the combination must be positively recited (e.g., --An assembly comprising a motor and transmission connected by a connecting device--). A connecting device merely "configured" to connect an engine

- and transmission does not actually require an engine or transmission, but merely the capability to use as such. As detailed above this capability is presumed to be present in the prior art connecting device until applicant proves otherwise with evidence.
- Mere allegation that the prior art is incapable of performing the claimed function, in a declaration or otherwise, is not considered proper evidence much less proof (*In re Schreiber*, 128 F.3d 1473, 1478 44 USPQ2d 1429, 1432 [Fed.Cir.1997]).
  - Anticipation of the **claimed structure** automatically results in the assumption of the function to be inherent and further automatically shifts the burden to address functional limitations to the applicant regardless of whether or not the examiner specifically addresses the functional limitations. This is necessary since the Patent Office is unable to obtain, test or compare prior art products. See *Ex parte Martin et al*, decision of the Board of Patent Appeals and Interferences, Patent No. 6,920,019, the paper filed on 11/19/2004, pages 6 and 9. Note that citation of an unpublished decision of the Board of Patent Appeals and Interferences is proper when it is available to the public in the patented file, in accordance with MPEP §707.06. Further note that the examiner is "required or authorized" to adhere to such prior decisions in accordance with the Forward and Introduction section of the MPEP.

Claim 2. Zagorski discloses the connecting device as recited in claim 1. Furthermore:

- The prior art at least one connecting element is fully capable of being substantially rigid (in that it is metal) in a direction (Z) radial to an axis of a motor shaft.

Claim 3. Zagorski discloses the at least one connecting device as recited in claim 1, wherein the connecting element is substantially (when compared to ceramics) elastically deformable (in that the prior art is metal).

- The prior art connecting element is fully capable of performing the intended use of being embodied such that it is orientated with respect to a motor shaft substantially deformable in a direction axial to an axis of a motor shaft.

Claim 4. Zagorski discloses the at least one connecting device as recited in claim 1.

Furthermore:

- The prior art connecting element is fully capable of performing the intended use of being configured to connect a motor housing to a transmission housing, spaced axially apart from it.

Claim 5. Zagorski discloses the connecting device as recited in claim 1, wherein the connecting element is U-shaped.

Claim 6. Zagorski discloses the connecting device as recited in claim 5, wherein the connecting element has a first leg (left leg of 14) and second leg (right leg of 14) that are connected to each other by a bridge piece (top bridge portion of 14).

Claim 7. Zagorski discloses the connecting device as recited in claim 6, wherein it is possible (though not necessary) to connect the connecting element to a motor housing in a region of an end surface of the first leg.

Claim 8. Zagorski discloses the connecting device as recited in claim 6, wherein it is possible (though not necessary) to connect the connecting element to a transmission housing in a region of an end surface of the second leg.



Claim 9. Zagorski discloses the connecting device as recited in claim 6, wherein the connecting element has a recess (recess in 14 receiving 38) and in the region of the recess, the connecting element is substantially concave.

Claim 10. Zagorski discloses the connecting device as recited in claim 9, wherein the recess has an **approximately** (but not necessarily exactly) ellipsoidal form (in that the recess is a non-circular curve similar to a portion of an ellipse).

Claims 1, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Henderson (U.S. Patent 5,237,871).

Claim 1. Henderson discloses (figs.1-6) **all of the claimed connecting device structure as follows**; a connecting device, comprising: at least one connecting element (visco elastic coated springs of col.2, ll.25-35; and plastic rings of col.7, ll.60-63) wherein relative to an axial dimension and a radial dimension of the at least one connecting element the at least one connecting element is embodied as thin (relative to thicker objects) in a predetermined circumference direction. Furthermore:

- Note applicant's statement that "only the connection device is intended to be claimed, NOT a combination of the connecting device with the various elements to be connected" (lines 17-18 of page 9 of the Remarks filed 12/17/2007).
- As detailed above, the prior art "connection device" structure is substantially identical to the claimed structure such that claimed properties or functions are presumed to be inherent, thus presenting a *prima facie* case (*In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 [CCPA 1977]) and properly shifting the burden of submitting

evidence proving otherwise to the applicant (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 [Fed.Cir. 1990]) in accordance with MPEP §2112.01 (I).

- Mere allegation that the prior art is incapable of performing the claimed function, in a declaration or otherwise, is not considered proper evidence much less proof (*In re Schreiber*, 128 F.3d 1473, 1478 44 USPQ2d 1429, 1432 [Fed.Cir.1997]).
- See also *Ex parte Martin et al*, decision of the Board of Patent Appeals and Interferences, Patent No. 6920019, the paper filed on 11/19/2004, pages 6 and 9. Note that citation of an unpublished decision of Board of Patent Appeals and Interferences is proper when it is available to the public in the patented file, in accordance with MPEP §707.06.

Claim 11. Henderson discloses the connecting device as recited in claim 1, wherein the connecting element is at least partially comprised of an elastic plastic (plastic rings of col.7, ll.60-63). Note that all plastics inherently have some degree of elasticity.

Claim 12. Henderson discloses the connecting device as recited in claim 1, wherein the connecting element is at least partially coated with a viscoelastic material (visco elastic coated springs of col.2, ll.25-35).

### ***Response to Arguments***

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

All of applicant's claimed limitations are met by the prior art within the broadest reasonable interpretation of the claim language. Subject matter that is not recited in the claims

cannot be relied upon to persuasively argue for allowability. Claimed limitations cannot be persuasively argued to have a scope narrower than that, which is reasonably most broad. In a product claim, intended use, labeling and functional language cannot overcome the prior art wherein the prior art discloses structure fully capable of performing such uses and functionality. Capability need not be expressly stated in the prior art wherein it is inherent to the structure. Such inherency of functional capability is presumed to be present in the prior art structure until applicant proves otherwise with submission of actual evidence, in accordance with MPEP 2112.01(I).

The applicant's arguments regarding the dimensional and direction limitations added to claim 1 are not persuasive. As detailed in the 112 2<sup>nd</sup> paragraph rejections above, those limitations are unclear and appear to be present in the prior art as best understood by the examiner.

The applicant argues that the prior art does not disclose the limitations involving the motor housing, motor, transmission housing and transmission. This is not persuasive. As detailed above, the applicant is claiming a "connecting device" that is merely intended to be used with these elements, not a connecting device used in combination with these elements, such that patentability must be obtained based upon the device itself rather than elements merely intended to be used therewith. Note also applicant's statement that "only the connection device is intended to be claimed, NOT a combination of the connecting device with the various elements to be connected" (lines 17-18 of page 9 of the Remarks filed 12/17/2007). Prior art need only present structure capable of performing applicant's intended use limitations. The prior art need not specifically describe the intended use or functional limitations, nor specifically describe the

capability to perform as such where such capability is inherent to the prior art structure.

Inherency of capability to perform intended use and functional limitations is automatically presumed in prior art that sets forth all of applicant's **claimed** structure until the applicant proves otherwise. See MPEP 2112.01.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

August 22, 2008

/Victor MacArthur/  
Primary Examiner, Art Unit 3679